

### REMARKS

The issues outstanding in the Office Action mailed May 5, 2004, are the rejections under 35 U.S.C. § 112, 102 and 103 and the doctrine of obviousness-double patenting. Reconsideration of these issues, in view of the following discussion, is respectfully requested. The traversal of the requirement for restriction is maintained.

#### Rejections Under 35 U.S.C. § 112

Claims 1-3, 5-7, 9-13, 15-21, 25, 26, 28, 30, 33, 35-50, 55-57, 59 and 63-71 have been rejected under 35 U.S.C. § 112, first paragraph is failing to comply with the written description requirement. Reconsideration of this rejection is respectfully requested.

It is argued, page 2 of the Office Action, that the specification fails to provide “express” support for the lower limit of 35% recited for amorphous polyamide (B). The Office Action concludes that, since no “express” support can be found for the limitation, it is new matter. This is respectfully submitted not to be the legal standard. The Federal Circuit’s predecessor court clearly stated that the absence of express support is *not* determinative of written description. See *In re Wertheim*, 191 USPQ 90 (CCPA 1976). In *Wertheim*, the Court found to be supported a numerical range which was not expressly disclosed, but within the limits of a broader disclosed range, concluding that it would have been clear to one ordinary skill in the art that the applicants’ invention included all the values within the broadly disclosed range. Thus, the Court permitted selecting a value within the range for recitation in a claim, despite the absence of an express recitation of that value. Indeed, satisfaction of the written description part of § 112 is based on the perspective of one of ordinary skill in the art, and does not require “*ipsis verbis*” description. See *In re Smith*,

178 USPQ 620 (CCPA 1973), where the Court held that the test of written description is whether one of ordinary skill in the art would recognize the subject matter later claimed as being part of the invention. Wertheim, *supra*, suggests that one of ordinary skill in the art would do so, where the later claimed subject matter is a range subsumed within a broader disclosed range.

Consistent with the above discussion, and indeed based on *In re Wertheim*, the Patent Office's own Board of Appeals has held, in *McLaughlan v. Roberts*, 197 USPQ 831(POBI 1978) that a disclosure of the range of 10-79%, with preferred ranges of 40-79% and 40-60%, supported a later added claim of 10-25%, even though 25 was nowhere disclosed in the specification.

Accordingly, it is submitted that the range of 5-35% of amorphous polyamide (B) is clearly supported by the disclosure in the specification of the range of 5-40%. Values short of 40% are clearly within the scope of the present invention as moreover, disclosed in Tables 1 and 2 at pages 21 and 24 of the specification. As a result, it is submitted that claim 1 fully satisfies the written description requirement of the statute, and withdrawal of this rejection is respectfully requested.

Finally, it is submitted that, although the rejection was applied to all the claims, even under the Office Action's requirement of *explicit* support, at least original claims 13 and 15-20, and claims 63-71, which recite a value supported in the examples, clearly have written description in the specification, and should not be rejected on this basis.

The above noted claims have also been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in view of overlap between components (C2), (D) and (M). Applicants respectfully disagree with this assertion.

It is maintained that, accepting the accuracy of the assertion of overlap, such does not violate the requirement of definiteness. In particular, the M.P.E.P states that the "double inclusion of an

element by members of a Markush group is not, in itself, sufficient basis for objection to a rejection of claims.” See M.P.E.P § 2173.05(h). The MPEP continues that the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. Thus, inasmuch as one of ordinary skill in the art can clearly determine what is meant by each of components (A), (C), (D) and (M), there is no indefiniteness from the possibility that there may be overlap between one or more of these components. As a result, it is submitted that these recitations are not indefinite. This discussion has not been commented upon in the prior Office Action, although similar arguments were advanced previously. However, it is submitted that overlap, the apparent basis for this rejection, simply cannot be assumed to result in indefiniteness. Where, as here, each of the individually defined components can be readily understood by one of ordinary skill in the art, some overlap between those definitions does not counteract that understanding. Moreover, it is clear from the current amendments that component (C) must be present, and must be distinguishable (a “further” polyamide (C)). Withdrawal of this portion of the rejection is therefore appropriate, and is strongly urged.

Various other grammatical and typographical changes have been made to the claims, in view of the typographical errors noted at page 3 of the Office Action. The careful reading of the claims is appreciated. It is noted that the term “functionalized” is clearly definite as to scope and meaning. For example, see page 18, lines 15-25 of the specification, defining a “functionalized” polyolefin as a polymer comprising  $\alpha$ -olefin units and epoxy or carboxylic acid or carboxylic anhydride units. The use of the short hand term “functionalized” is clearly definite in view of the specification.

Moreover, it is submitted that the use of the term PEBA in claim 67 clearly further limits polyamide (C) of claim 66. Claim 66 recites that polyamide (C) is a copolymer of PA-12 and a

polytetramethylene glycol. At page 22, lines 14-16, PEBA is defined as a copolymer having PA-12 blocks with Mn of 5,000 and PTMG blocks with a Mn of 650 and an MFI of 4-10. Thus, PEBA is defined more narrowly than the embodiment of the polymer recited in claim 66, and claim 67 is properly limiting.

In conclusion, it is submitted that the claims fully and unequivocally satisfy the requirements of § 112 of the statute, withdrawal of this rejection in its entirety is respectfully requested

Rejections under 35 U.S.C. § 102 and 103

Claims 1-3, 13, 15-21, 25, 26, 28, 30, 33, 37, 41-44, 46-50, 63, 65, 68 and 71 have been rejected under 35 U.S.C. § 102(b), or in the alternative 103, over Dalla Torre '087. Reconsideration of this rejection is respectfully requested. It is apparent that this rejection is based on the allegation that C2, D, or M in the present claims overlaps with components A and B, and thus a reference disclosing the simply components A and B is argued to anticipate these claims. This is respectfully submitted not to be accurate. In particular, it will be recalled that Dalla Torre is directed to "transparent, colorless *and* amorphous" polyamides. See column 1, lines 65-66. Patentees teach that these *amorphous* polyamides are made up of cycloaliphatic diamines and aliphatic dicarboxylic acids, or aliphatic diamines and cycloaliphatic dicarboxylic acids. See column 2, lines 1-8. Patentees indicate that materials may be present as a blend with a "further polyamide." See column 2, lines 12-18. "Further polyamide" is defined at column 3 as comprising homopolyamides and copolyamides in an amount of up to 60% by wt. Further "homopolyamides" are listed at column 3, lines 5-15, and include PA 11 and PA 12. Example 4 of the patent shows 50% of polyamide and 50% of PA 12. As a result Patentees fail to suggest the production of an overall *semi-crystalline*

blend, containing, for example, 35% or less of amorphous polyamides as in claim 1. (See also claims 13-20 and 63-71.)

It is thus maintained that patentees clearly fail to suggest the production of a semi-crystalline composition, particularly since their “object” is obtained by the production of an *amorphous* material. Moreover, one of ordinary skill in the art would have no motivation to modify the materials of the patent, inasmuch as the expectation in the art is that transparent materials, *required* in the patent, necessitate the use of amorphous polyamides rather than semi-crystalline ones. Typically, one of ordinary skill in the art would not expect that compositions as presently claimed would be transparent. However, the examples in the present application clearly show that transparency is achieved.

Moreover, the reference simply fails to disclose or suggest the use of a further polyamide which is a copolymer with polyamide blocks and polyether blocks. See component (C) in claim 1. At column 3, lines 5-12 of Dalla Torre, the “further polyamides” and copolyamides are listed but do not disclose or suggest such block of copolyamides. Indeed, the omission of claim 6 from this rejection clearly evidences is the patentability of claim 1.

Moreover, Dalla Torre fails to disclose or suggest newly added independent claim 72 which requires a compatibilizer which is a *catalyzed* polyamide, as discussed further below in connection with the dependent claims. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 5-7, 9-12, 35, 36, 38-40, 45, 55-57, 59, 64, 66, 67, 69, and 70 have been rejected under 35 U.S.C. § 103 over Dalla Torre taken with Blondel ‘172, Schmid ‘799 and Giroud-Abel ‘213. Reconsideration of this rejection is also respectfully requested.

The majority of these rejections are directed to various features of the dependent claims. However, it is submitted that the combination of reference does not remedy above noted deficiency of Dalla Torre. While it is argued at page 5 of the Office Action that the use of functionalized polyolefins and polyesteramides are known impact modifiers for polyamide compositions, it is again submitted that one of ordinary skill in the art would not combine Schmid or Giroud-Abel with Dalla Torre, for example, as such would result in the use of more semi-crystalline material than the maximum amount disclosed in Dalla Torre, which would result in an overall semi-crystalline composition. Such a presumably non-transparent composition is taught as being unsuitable in the primary reference. Moreover, Schmid discloses, consistently with the prior art, amorphous polyamide containing aromatic units. Accordingly, the combination of Schmid and Dalla Torre would not suggest the presently claimed blend.

Giroud-Abel teaches the conventionality of adding elastomers to blends but does not particularly suggest the addition of the block component (C) herein to a composition such as that of the primary reference. The polyamide compositions of Giroud-Abel contain a “semi-rigid” copolyamide prepared from fatty acid dimers and an elastomer comprising recurring units, such as olefinic copolymers, copolyesteramides, polyurethanes, organopolysiloxanes, etc. Thus, it is not seen that the patent is specific enough to suggest to one of ordinary skill in the art the use of block copolymers such as present component (C), in a composition such as that of Dalla Torre, which is, for example, an amorphous polyamide and a transparent copolyamide.

Moreover, it is submitted that this combination of references fails to suggest the use of a compatibilizer which is a catalyzed polyamide. While it is speculated at page of the Office Action, that the primary reference’s polyamide-containing composition would “meet the requirements of

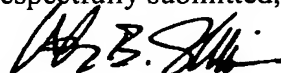
applicants' 'catalyzed' polyamide since it would necessarily contain the catalyst during subsequent steps of the preparation of the compounds," it is not seen upon what basis this supposition is grounded. Indeed, while it is possible to add the catalyst to polyamide (D) after it has been prepared, as noted at page 6 in the Office, this is not seen to suggest the incorporation of catalyzed polyamide as a modifier. The logic is simply not understood.

Accordingly, it is submitted that the combination of references fails to suggest the present claims, withdraw of this rejection is also respectfully submitted.

The claims of the application are submitted to be in condition for allowance. However, if the Examiner has any questions or comments, she is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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